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EXAMINER

CHUKWURAH, NATHANIEL C

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/049,546
Filing Date: June 05, 2003
Appellant(s): KRAENZLER ET AL.

MAILED
APR 02 2008
GROUP 3700

Michael Striker
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/14/2007 appealing from the Office action mailed 2/1/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,699,865	FORDERER et al.	12-1997
5,046,566	DORNER et al.	9-1991
5,697,456	RADLE et al.	12-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 16- 17, 19-20, 22-26, 28 and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forderer et al. (US 5,699,865) in view of Dorner et al. (US 5,46,566).

With regard to claim 16, Forderer et al. et al. discloses a power tool with at least one handle (19) which comprises at least one grip part (19) firmly connected to and held at a mounting part (35, 45) by at least one elastic, vibration-damping element (22) between the grip part (19) and the mounting part (35, 45), and the grip part affixable to a housing (2), via the mounting part (35 , 45), and the connection between the grip part (19) and the mounting part (35, 45) by means of the elastic element is secured by at least one movable retaining element (50). See (col. 5, line 29).

The elastic element does not require the condition of preventing the separation of the grip part from the housing if damaged, to meet the limitation.

The reference of Forderer et al. discloses all claimed subject matter but lacks specific teaching of the retaining element firmly connected to a fastening screw located in mounting part.

However, the power tool of Dorner et al. teaches a retaining element (50, 60) firmly connected to a fastening screw (55) located in mounting part (41) for holding the elastic element fixedly to the motor.

In view of the teaching of Dormer et al., it would have been obvious to one skilled in the art at the time of the invention to provide the power tool Forderer et al. with a fastening screw in order to hold the elastic element fixedly to the motor and to prevent transferring vibrations from the motor to the handle unit.

With regard to claim 17, Forderer et al. does not expressly state that the retaining element is flexible. The retaining element (50) is inherently flexible to a degree.

With regard to claim 19, the retaining element (50) is located in the elastic element (22) along a center line (see Fig. 2).

With regard to claim 20, retaining element (50) is capable of being subjected to tensile stresses and the elastic element (22) is capable of being subjected to compressive stresses.

With regard to claims 22 and 23, the retaining element (50) is formed by a rigid component that is rigidly supported and capable of moving relative to the mounting part (45) and grip part (19).

With regard to claims 24 and 25, the power tool of Forderer et al. discloses all claimed subject matter but lacks specific teaching of the retaining element firmly connected to a fastening screw located in mounting part.

However, the power tool of Dorner et al. teaches a retaining element (50, 60) firmly connected to a fastening screw (55) located in mounting part (41) for holding the elastic element fixedly to the motor.

In view of the teaching of Dormer et al., it would have been obvious to one skilled in the art at the time of the invention to provide the power tool Forderer et al. with a fastening screw in order to hold the elastic element fixedly to the motor and to prevent transferring vibrations from the motor to the handle unit.

With regard to claim 26, the power tool of Forderer et al. includes the retaining element (45) being connected to the grip part (19) via the elastic element (22) and to the mounting part (35) via the elastic element (22).

With regard to claim 28, the power tool of Forderer et al. includes elastic element comprising non-circular cross-section area at least closely before the seating surface (36) of the elastic element (22) for the mounting part (35) and grip part (19) wherein the cross-sectional area is smaller than the seating surface (Fig. 2).

With regard to claim 33, the power tool of Forderer et al. includes a retaining element (50) enclosed by the elastic element (22).

With regard to claim 34, the grip part (9) of the power tool of Forderer et al. comprises a recess (90), in which the retaining element is located.

With regard to claim 35, the recess (90) of the power tool of Forderer et al. is partially filled with the elastic element (22).

With regard to claim 36, means for the retaining the grip part is deemed connected to the mounting part in captive fashion.

With regard to claim 37, the modified retaining element of Forderer et al. includes a screw (55) having a screw head which is larger than the recess as shown in Figure 2 of Dormer et al.

With regard to claim 38, the power tool of Forderer et al. includes the elastic element having a flange gripping behind an edge region of the recess (see flanged section of elastic element around edge region of recess (90)).

With regard to claim 39, the modified retaining element of Forderer et al. includes the elastic element (Dorner et al. 30, 60) has a flange (Dorner et al. Fig.2) preventing a direct contact between the screw head and the grip part (Dorner et al. 6).

Claim Rejections - 35 USC § 103

7. Claims 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forderer et al. in view of Radle et al. (US 5,697,456).

With regard to claim 21, the power tool of Forderer et al. discloses all claimed subject matter but lacks specific teaching of the retaining element formed by a band which encloses the elastic element.

The power tool of Radle et al. teaches a retaining element (100) formed by a band which encloses the elastic element (96, 98) for protective covering.

In view of the teaching of Radle et al., it would have been obvious to one skilled in the art at the time of the invention to incorporate into the power tool Forderer et al. the retaining element formed by a band enclosing the elastic element for protective covering.

With regard to claim 27, the displacement of the elastic element (22) is determined by the retaining element (50) in tilting direction.

(10) Response to Argument

A. Examiner interpretation of the independent claim

During patent examination of the claims, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). *See also* MPEP § 2111. Moreover, while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, *this is not the mode of claim interpretation to be applied during examination*. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). *See also* MPEP § 2111.01.

Independent claim 16 recites:

A power tool with at least one handle, said handle comprising at least one grip part that is firmly connected to and firmly held at a mounting part by at least one elastic, vibration-damping element located between the grip part and the mounting part, wherein the grip part is affixed to a housing via the mounting part which is screwed into the housing so that the elastic element is mounted to the housing through the mounting part and also mounted to the grip part; and wherein the connection between the grip part and the mounting part by means of the elastic element is secured by at least one movable retaining element that prevents a separation of the grip part from the housing if the elastic element is damaged and ensures control of the power tool via the grip part at all times.

B. The rejection of claim 16 and its dependent claims under 35 U.S.C. § 103(a) is proper and should be affirmed.

Appellant is arguing on page 9, that it would have not been obvious to combine the teaching of Dorner et al. with the primary reference of Forderer et al. since neither reference discloses any retaining element for preventing the loss of the handle from the motor system in the event of failure of the vibration-damping element.

Appellee is aware that there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) . *See also* MPEP § 2143.01.

In this instance, Forderer et al. disclose the invention as claimed including the retaining element (50). While it is generally known that vibration-damping element is for reducing vibration of the inner working parts of a tool, it is implicit in Forderer et al. Further, Forderer et al.'s vibration-damping element does not require the condition of "preventing a loosening of the grip part from the housing in the event of a damage to the elastic element" in order to reduce vibration of the inner working parts of the tool for the comfort of the user.

The teaching of Dorner et al. was chosen to show Appellant that it is obvious to provide a screw in place of non-screw retainer.

Appellant has not overcome the *prima facie* burden of obviousness as the Appellee has provided sufficient motivation to reject the claim under Forderer et al. in view of Dorner et al. The § 103(a) rejection of claim 16 and its dependent claims should be affirmed.

C. The rejection of claims 21 and 27 under 35 U.S.C. § 103(a) is proper and should be affirmed.

Appellant is arguing on page 12, that Radle does not disclose the new features of the present invention. The teaching of Radle was chosen to show Appellant that it is obvious to provide a band stretchable to accommodate displacement of retainer.

Appellant has not overcome the *prima facie* burden of obviousness as the Appellee has provided sufficient motivation to reject the claim under Forderer et al. in view of Radle.

The § 103(a) rejection of claim 2 should be affirmed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Nathaniel Chukwurah


Conferees:

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